

REMARKS/ARGUMENTS

Claims 1-57 are pending in the above application.

The Office Action dated April 2, 2009, has been received and carefully reviewed. In that Office Action claims 32-54 and 55-57 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. In addition, claims 1-8, 12-38 and 42-57 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Rogers. Claims 9-11 and 39-41 were objected to as being dependent upon rejected base claims but were indicated to be allowable if amended to include the limitations of their base claims. It is believed that the pending claims patentably distinguish over the art of record, and reconsideration and allowance of claims 1-8, 12-38 and 42-57 is respectfully requested in view of the following remarks. Because all claims are believed to be allowable, the objected-to claims, claims 9-11 and 39-41, are not being rewritten in independent form at this time.

REQUEST FOR WITHDRAWAL OF PREMATURE FINALITY

Claims 32-54 were rejected under 35 U.S.C. 101 in an April 23, 2008, Office Action. These rejections were traversed in a response filed July 22, 2008. The next Office Action, dated October 8, 2008, did not repeat these rejections or respond to Applicant's traversal of these rejections. Since these rejections were not repeated, they were deemed to be withdrawn (MPEP 707.07(e)).

The present Office Action also rejects claims 55-57 under 35 U.S.C. 101. These claims were not previously rejected under 35 U.S.C. 101. Claims 55 and 56 are original claims, and no amendment on the part of Applicant necessitated this new rejection.

It is respectfully submitted that if the examiner wishes to raise these rejections again and/or add new rejections under 35 U.S.C. 101, the new rejections must be raised in a non-final Office Action. Furthermore, Applicant's arguments against the Section 101 rejections must be addressed as required by MPEP 707 because these arguments remain relevant (see note to form paragraph 7.38 in MPEP 707.07(f)). For these reasons, it is respectfully submitted that the present Office Action is prematurely final, and the withdrawal of the finality of the Office Action is respectfully requested.

If the finality of the Office Action is not withdrawn, it is respectfully requested that the examiner cite the legal authority that allows a new rejection of unamended claims to be raised in a final Office Action (when exceptions, such as the filing of an IDS, do not apply).

RESPONSE TO NEW REJECTION

The rejection of claims 55-57 reads in full: "Claims 55-57 are rejected under 35 U.S.C. 101 because as method claims they are running with the article manufacture claims above." It is respectfully submitted that this rejection is not based on any legal authority, and the withdrawal of the rejection is respectfully requested. If the rejection is maintained, it is respectfully requested that the examiner identify the statute, case or MPEP section that provides for claim rejections based on a "running with the article of manufacture" rationale so that the ground for the rejection can be understood.

REQUEST FOR RESPONSE TO ARGUMENTS OF RECORD

Section 101 Rejections

The present Office Action includes a rejection of claims 32-54 under 35 U.S.C. 101 that is nearly identical to the Section 101 rejection raised in the April 23, 2008, Office Action. Applicant hereby repeats the arguments that were presented against the Section 101 rejections on July 22, 2008, (which have not yet been addressed) and requests that the examiner answer these arguments as required by MPEP 707.07(f).

Claims 32-54 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Specifically, the Office Action indicates that an “article of manufacture” is non-statutory subject matter. It is respectfully submitted that the statute that defines patentable subject matter, 35 U.S.C. 101, which is quoted in the Office Action, lists a “manufacture” as patentable subject matter. “Article of manufacture” is also listed in a discussion of patentable subject matter in MPEP 2107.01. It is therefore respectfully requested that the examiner provide authority for stating that an article of manufacture is not statutory subject matter when such subject matter is explicitly listed in 35 U.S.C. 101.

It is noted that claims 32-54 recite in part, a computer readable medium having computer readable code thereon. This type of subject matter is also patentable as held by the Federal Circuit in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995) (“computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. Sec. 101 and must be examined under 35 U.S.C. Secs. 102 and 103.”) If the examiner is raising an objection to the form of the language used in connection with the claimed computer program embodied in a tangible medium, it is

respectfully requested that any such object be explained in greater detail in a further communication so that the basis for the object can be understood.

Section 103 Rejections

The rejections under 35 U.S.C. 103(a) in the present Office Action appear to be identical to the rejections raised in the October 8, 2008, Office Action. Applicant presented over three pages of substantive arguments against these rejections as well as several direct requests for clarification of the examiner's interpretation of the references if the rejections were maintained. It is respectfully submitted that copying three paragraphs of the arguments and then maintaining the rejection does not constitute "answering the substance of the arguments." The arguments from the January 2, 2009, Reply are copied below, and it is respectfully requested that the examiner answer the substance of these arguments as required by MPEP 707.07(f).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Rogers. Claim 1 recites a network device adapted to process a call between the network device and a first other network device. The network device comprises a user interface adapted to receive a user input requesting a call transfer to a second other network device and a call transfer function responsive to the user input to deliver call transfer functionality. Upon receipt of the user input, the call transfer functionality of the network device a) initiates a connection from the network device to the second other network device and b) sends a first message to the first other network device containing a reference to the second other network device. As acknowledged in the Office Action, Wang does not show or suggest a network device having a call transfer function responsive to user input by ... sending a first message to a first other network device

containing a reference to the second other network device. However, the Office Action asserts that it would have been obvious to modify Wang to satisfy this limitation based on the teachings of Rogers.

Rogers teaches a telecommunications system that controls a call transfer using a central network control system (NCS). When Roger's user-A is connected to user-B and to user-C, user-A can initiate a call transfer in order to connect user-B and user-C. This is done by sending "a request message 9 to NCS 20 requesting the set-up of communication between user-B 8 and user-C 14. A processor 24 accesses a database 22, located in NCS 20, to determine whether the requested transfer is allowed. NCS 20 then returns a response message 11 to switch A 6 responding to the request message 9 (column 3, lines 42-46)."

The interpretation of Rogers being used in the Office Action seems to require that Rogers' user-A correspond to the claimed "network device," that Rogers' user-B correspond to the "first other network device" and Rogers' user-C correspond to the claimed "second other network device." (If this is inaccurate, it is respectfully requested that the examiner clarify the interpretation being used in a further communication.) However, Rogers' user-A does not send a message to user-B containing a reference to user-C as would be required under this interpretation. Instead, Rogers' user-A sends a message to the network control system 20, and the network control system connects user-B to user-C. Therefore, even if Wang and Rogers were somehow combined, the result would not be a network device that includes a call transfer function that sends a first message to a first other network device containing a reference to the second other network device as recited in claim 1. Claim 1 is submitted to be allowable over Wang in

view of Rogers for at least this reason.

Furthermore, it is respectfully submitted that a proper reason for modifying Wang based on Rogers has not been provided. The proposed modification to Wang would change the principle of operation of Wang, and changing the principle of operation of a primary reference is never obvious. MPEP 2143.01. Wang transfers a call by sending various messages between Ethernet telephones as discussed at column 36, line 42 to column 37, line 6. Wang does not use a centralized network control system to handle a call transfer. Adding Rogers' centralized network control system to Wang for handling call transfers would therefore change the principle of operation of Wang and is therefore unobvious.

For the foregoing reasons, it is respectfully submitted that claim 1 patentably distinguishes over Wang in view of Rogers, and the withdrawal of the rejection of claim 1 based on Wang and Rogers is respectfully requested. If the rejection is not withdrawn, it is respectfully requested that the examiner identify 1) which elements of Rogers are believed to correspond to the claimed "network device," "first other network device" and "second other network device" and 2) what message a call transfer function of the network device sends to the first other network device that contains a reference to the second other network device so that the basis for this rejection can be better understood.

Claims 2-8 and 13 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Independent claims 14, 22, 32, 44, 51, 55, 56 and 57 were rejected under 35 U.S.C. 103(a) for the same reasons as claim 1. No further discussion of these claims is

provided in the Office Action. While the limitations of these claims are different than those of claim 1, the arguments presented above in connection with claim 1 are applicable to the above-recited claims. Claims 14, 22, 32 44, 51, 55, 56 and 57 are therefore submitted to be allowable for at least the reasons provided above in connection with claim 1. The claims depending from claims 14, 22, 32 44, 51, 55, 56 and 57 are submitted to be allowable at least because of their dependency from allowable claims.

Independent claim 27 is rejected as being unpatentable over Wang in view of Rogers because "Wang in combination with Rogers disclose all the limitations of claim 27 as stated in claim 1's rejection above." However, claim 27 does not include the same limitations as claim 1 and does not include the limitation regarding the transmission of first and second messages discussed in the rejection of claim 1. Section 706.02(j) sets forth the requirements for establishing a rejection based on obviousness. As provided by that section, the examiner "should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made." None of these requirements have been satisfied in the present rejection of claim 27. A prima facie case of obviousness has therefore not been presented in connection with claim 27, and the allowance of claim 27 is respectfully requested.

CONCLUSION

Each issue raised in the Office Action dated April 2, 2009, has been addressed, and it is believed that claims 1-57 are in condition for allowance. Wherefore, the withdrawal of the finality of the Office Action and reconsideration and allowance of these claims are respectfully requested. If the examiner believes that any additional changes would place the application in better condition for allowance, the examiner is invited to contact Scott Wakeman (Reg. No. 37,750) at the telephone number listed below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3828 and please credit any excess fees to such deposit account.

Respectfully submitted,

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